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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,909	03/14/2005	Tomoaki Endoh	03500.017742.	9057

5514 7590 04/14/2009

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EXAMINER	
JOHNS, CHRISTOPHER C	
ART UNIT	PAPER NUMBER
3621	
MAIL DATE	DELIVERY MODE
04/14/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/527,909	ENDOH, TOMOAKI	
	Examiner	Art Unit	
	Christopher C. Johns	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-10,12,13 and 32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-10,12,13 and 32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Claims 1-4, 6-10, 12, 13, and 32 are pending.

2. This Office Action is given Paper No. 20090403 for reference purposes only.

3. This Office Action is in response to the Request for Continued Examination, filed 26 February 2009.

4. All references to the capitalized version of "Applicant" refer specifically to the Applicant or Applicants of record in the instant application. Any references to lowercase versions of "applicant" or "applicants" refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.

Continued Examination Under 37 C.F.R. §1.114

5. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 February 2009 has been entered.

Claim Rejections - 35 USC § 112 1st Paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-4, 6-10, 12, 13, and 32 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Independent claims 1, 7, 13, and 32 recite "acquiring, via a network…device identification information" (7, 13). This is unsupported by the specification or claims as originally filed. Based on the disclosure, it would seem that a device's identification information would not need to be acquired *by the device* through a network.

Claim Rejections - 35 USC § 112 2nd Paragraph

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-4 and 6 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. The claim element "recognition means for recognizing" is a means (or step) plus function limitation that invokes 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function - there is no

corresponding device that explicitly recognizes a correspondence between two sets of "device identification information".

11. Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. §112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

12. If Applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. §132(a)).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claims 1-4, 6-10, 12, 13, and 32 are rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent Application Publication 2001/0034846 ("Beery") in view of the Internet Archive Wayback Machine's archive of Adobe InDesign 1.5 ("Adobe").

15. As per claims 1, 7, 13, and 32, Beery discloses:

16. management means for managing license information that has already been installed in the apparatus (figure 5, reference 200);

17. license information indicating an amount of allowed usage of a program executable on the apparatus or a function of the apparatus (figure 5, reference 80-84 - the user is able to use the software to get the missing data chunk);

18. license identification information corresponding to the license information, wherein the management means manages the information (figure 5, reference 89);

19. acquisition means for acquiring, via a network, license identification information identifying license information, device identification information and license information indicating an amount of a change in a right of usage of the program (figure 5b, reference 250 – the software package includes the licensing information for the software as well as the device identification sent earlier in steps 232, 233, 236);

20. determination means for determining whether the acquired license identification information corresponding to the acquired license information is included in the license identification information managed by the management means so as to avoid a duplicate installation of the license information (if the software already has the missing chunk, it will not be requested nor installed);

21. recognition means for recognizing the whether the acquired device identification information corresponds to device identification information of the apparatus (figure 5b, reference 250, 252, 254, 256);

22. installation means for, if the determination means determines that the acquired license identification information corresponding to the acquired license information is not included in the license identification information managed by the management means, and if the recognition means recognizes that the acquired device identification corresponds to the device identification information of the image forming apparatus, installing the acquired license information to increase the amount of allowed usage of the program (figure 5c, reference 362, 374, 364);

23. wherein the installation means does not install the acquired license information if the determination means determines that the acquired license information corresponding to the acquired license information is included in the license identification information managed by the management means or if the recognition means recognizes that the acquired device identification information does not correspond to the device identification information of the image forming apparatus (figure 5c, reference 364 – "if registration ok, then allow H1 to continue"; implying that if the registration is NOT okay, then H1 would not continue).

24. Beery does not explicitly disclose:

25. image forming apparatus;

26. managing license information by using a counter.

27. Adobe teaches:

28. image forming apparatus (page 2, "Adobe® InDesign® 1.5 software is redefining professional publishing for graphic designers, production artists, and prepress professionals…");

29. managing license information by using a counter (page 2, "Free 60-day tryout version"; "Download or order a free 60-day tryout version of Adobe InDesign 1.5.2").

30. Adobe teaches this to enable a demonstration version of software, well-known to those skilled in the art at the time of the invention as a method for distributing trial versions of software without giving the entire functionality away for free. This enables a system where users are more satisfied (as they are able to try out the software and evaluate it before purchasing) and where merchants are more satisfied (as customers who know what they are getting into are more likely to buy the software).

31. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Beery the trial system as taught by Adobe, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it creates a system that users are more likely to use and purchase.

32. As per claims 2 and 8, Beery in view of Adobe discloses as above, and further discloses:

33. management means further manages expiration-date-of-installation information indicating a period during which the license information acquired by the acquisition means is valid (¶10 – "time sensitive token"; ¶12 – "exceeded the licensed time limit");

34. authentication means for authenticating the expiration date of installation of the license information (¶10 – "time sensitive token which is encrypted").

35. As per claims 3 and 9, Beery in view of Adobe discloses as above, and further discloses:

36. management means manages an encryption key of an already-installed program code (claim 3 – "said data or software being encrypted by standard encryption technology") together with program identification information identifying the program (figure 5b, reference 246, 248)

37. As per claims 6 and 12, Beery in view of Adobe discloses as above, and further discloses:

38. management means manages license information in the form of certification information, which certifies the right of a particular amount of usage of the program installed on the image forming apparatus or the function of the image forming apparatus (the license certifies that the program is able to act in a certain way)

39. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beery in view of Adobe, further in view of Official Notice.

40. As per claims 4 and 10, Beery in view of Adobe teaches as above, but does not explicitly teach:

41. acquired license information encrypted using an encryption key uniquely assigned to the image forming apparatus;

42. image forming apparatus comprises decryption means for decrypting the encrypted license information

43. It is Admitted Prior Art that the idea of "device keys" was old and well-known in the art because it allows for a device-centric method of encrypting data, which does not depend upon user keys to be entered. Device keys have been used in countless Digital Rights Management systems, and are known to be advantageous because they allow for a stronger system - if a device is known to act in a way that the content owners do not desire, the solution is to no longer issue content tied to that device. This is accomplished by encrypting data to a key in such a way that it is only decryptable by a specific unit

44. The prior art is replete with this idea (see, for example, United States Patent Application Publication 2002/0007456, paragraph 312 - "To constitute the code image 78, and in one embodiment of the present invention, there is a manufacturer-specific device key KMAN which is unique to each portable device 62 but independent of the CPU key 66. The purpose of KMAN is to allow each device manufacturer to administrate its device secrets independently").

45. Therefore, it would have been obvious to a person having ordinary skill in the art to include in a "device key" in Beery and Adobe, since the claimed invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable. Furthermore, a person having ordinary skill in the art would see this as advantageous because it allows for a more secure system - if a device is found to be non-compliant, a content creator merely has to cease issuing content tied to that device, and the chain of data security remains intact.

Response to Arguments

46. Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground of rejection. They argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

Conclusion

47. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. United States Patent Application Publication 2003/0156719 (Cronce);

b. United States Patent Application Publication 2002/0100036 (Moshir et al);

c. United States Patent Application Publication 2007/0107067 (Fountian).

48. Examiner's Note: Although Examiner has cited particular columns, line numbers and figures in the references as applied to the claims above for the convenience of the applicant(s), the specified citations are merely representative of the teaching of the prior art that are applied to specific limitations within the individual claim and other passages and figures may apply as well. It is respectfully requested that the applicant(s), in preparing the response, fully consider the items of evidence in their entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. Furthermore, it must be noted that the documents cited on any enclosed PTO-892 or PTO-1449 form are cited in their entirety.

49. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

50. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

51. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/ANDREW J. FISCHER/
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